The Examiner bases his rejection on his inference that compound XXI was tested for inducing anesthesia. It is Applicant's position that this inference is not justified based on the disclosure of the Russell et al. patent. However, whether or not the compound was tested is believed irrelevant to the present claims. The mere fact that a compound was tested for anesthesia does not imply that it is an anesthetic. Screening is performed to find out if a compound has a desired property. The mere act of screening does not result in a compound having the property sought by screening. There is surely no teaching in the Russell et al. patent that would realistically lead one of ordinary skill in the art to the presently claimed method of use.

The Russell et al. patent clearly does not give the results of any test of Compound XXI. If anything, assuming arguendo that the compound was tested, the implication would be that any such test was unsatisfactory. The patent states: "The products of Example XIII, XIV, XVI and XXII and .....Example XVII were found to have anesthetic activity in these tests." The same was not said of Example XXI ("The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention". In re Lunsford, 148 USPQ 716, 53 CCPA 986, 357 F2d 380 (1966)).

Moreover, assuming arguendo that the Russell, et al. patent discloses that compound XXI was tested, the Examiner's conclusion that this single experimental test would be a prior occurrence of the claimed method of use is contrary to patent law precedent. The mere fact that a compound has been tested for anesthetic properties certainly does not disclose a utility or a reduction to practice. There is simply no evidence to

suggest that the compound XXI had any such use. If tests were actually conducted, the results of such tests are not prior art, since it was applicant's and assignee's own secret work, not public knowledge.

The only evidence of the presently claimed method of use is Applicant's own application, but that would be impermissible hindsight.

Nor does the mere art of testing support a rejection under 35 U.S.C. 103. "Slight reflection suggests, we think, that there is usually a element of 'obviousness to try' in any research endeavor .... and that patentability determinations based on that as the test would not only be contrary to the statute but result in marked deterioration on the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research'". In re Tomlinson, 150 USPQ 623, 626, 53 CCPA 1421 (1964). "As we have said many times, 'obvious to try' is not the standard of 35 USC 103". In re Antonie, 195 USPQ 6 (CCPA 1977). See also In re Goodwin, 198 USPQ 1 (CCPA 1978).

Claims 1-6 have been finally rejected under 35 USC 103 as being unpatentable over Terrell et al. '425, Terrell et al. '705 and Bagnall. The Examiner states that Terrell et al '425 teaches the 1-chloro derivative for inducing anesthesia, Terrell et al. '705 teaches the 1-bromo derivative for inducing anesthesia, and Bagnall teaches a similar compound where the 1-fluoro can be substituted for inducing anesthesia. The Examiner therefore concludes that Applicant's 1-fluoro derivative for inducing anesthesia would be prima facie obvious in the absence of a showing.

Applicants submit that the claimed use of a compound as an anesthetic is unobvious based on the structure of this compound, because we are here dealing with an art that is quite empirical and unpredictable.

To illustrate this point, the Examiner's attention is directed to "Changes in Power Spectra of Electroencephalograms during anesthesia with Fluorene, Methoxyflurane and Ethrane", by A.J. Bart, J. Houi, H.W. Linde, printed in Anesthesia and Analgesia, Vol. 50, No. 1 (1971). On page 62, it is stated that, "often there is a relatively small difference between molecules which depress and those which excite the central nervous system. For example, hexafluorodiethyl ether (fluothyl) is a clinically-used convulsant and its isomer hexafluoroisopropyl methyl ether, is a general anesthetic agent and incidentally capable of blocking fluothyl induced convulsions".

The previously submitted article by Aldrich et al, J. Org. Chem., 29 (14), pp 11-15 (1964) is further evidence of unpredictability, disclosing that $CF_3CF_2OCH_2F$, a structural isomer of the compound used in the present invention is a toxic convulsant.

Another article by Koblin et al. (Anesthesiology 54:314-7, 1981) compares the anesthetic properties of four structural isomers. One isomer is the anesthetic disclosed in U.S. Patent 3,555,425 to Terrell et al. Another isomer "compound 485" produces convulsions and clearly would not be a useful anesthetic.

These cited articles demonstrates that the anesthetic quality of a compound cannot (at least at present) be predicted from the structure of a molecule, even when the molecule is structurally close to a known anesthetic or several known anesthetics. It is submitted that one of ordinary skill would not have known if the compound of the present invention would be inert, a convulsant, or an anesthetic. Further, even if a compound has anesthetic properties, it is unpredictable whether it will have the profile of a satisfactory and safe anesthetic, i.e., stable, inflammable, non-toxic, etc.

It is therefore submitted that one skilled in the art would not have considered the claimed method of use to be obvious.

Even assuming arguendo that the present invention is structurally obvious, unexpected results are shown by the enclosed declarations. The enclosed declaration of Edmond I. Eger, M.D. shows a side-by-side comparison over the prior art 1-chloro anesthetic agent. As previously mentioned, this 1-chloro derivative is isoflurane, the most widely used inhalation anesthetic in North America. As requested by the Examiner's action of November 19, 1987, the enclosed declaration by Gerald G. Vernice shows a side-by-side comparison with the 1-bromo anesthetic agent.

Both declarations show an important improvement over the prior art compounds with respect to the recovery time of a patient following use of the compound.

In view of the above, it is believed that the invention is patentable and the application in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,

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Enclosures